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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/826,708	04/05/2001	Rabindranath Dutta	AUS9-2001-0048-US1	3963

			EXAMINER
46033	7590	10/31/2005	CHOUDHURY, AZIZUL Q

IBM CORPORATION
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ART UNIT	PAPER NUMBER
2145	

DATE MAILED: 10/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/826,708	DUTTA, RABINDRANATH
	Examiner	Art Unit	
	Azizul Choudhury	2145	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>16 August 2005</u>.

2a) ☒ This action is **FINAL**.   2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-26</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-26</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>05 April 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4/5/01</u>.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

Detailed Action

This office action is in response to the correspondence received on August 16, 2005.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-26 rejected under 35 U.S.C. 103(a) as being unpatentable over

Skladman et al (US Pat No: US006400810B1) in view of Lee et al (US Pat No:

US006212553B1), hereafter referred to as Skladman and Lee, respectively.

1. With regards to claims 1, 13 and 20, Skladman teaches through Lee, a method for

sending electronic mail (e-mail), from a sender to a plurality of recipients,

comprising: receiving input from said sender specifying said recipients of an e-mail

message; and for each of said recipients, receiving input from said sender to create

a tag indicating the importance of said e-mail message, wherein said tags may vary

from one of said recipients to another

(Skladman teaches an email design that allows recipients to set preferences (in

filters) including preferences based on email addresses and priority schemes

(column 2, lines 21-34, Skladman). In addition, Skladman's design features a

central storage location for the recipient's preferences (notification server) enabling

the recipient's preferences to be accessed allowing for customized notifications and

flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore,

Skladman's design allows for regular email features (column 3, lines 33-57,

Skladman) hence claimed traits such as the sender specifying recipients are present

within Skladman's design. However, the notification server sets the tags of

Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either

by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). This is

particularly shown within lines 58-60, in column 20.

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the

invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

2. With regards to claims 2, 14 and 21, Skladman teaches through Lee, the method

further comprising: providing a plurality of said tags with predefined content

(Skladman's design features a central storage location for the recipient's

preferences (notification server) enabling the recipient's preferences to be accessed

allowing for customized notifications and flags (tags) based on sender (column 3,

lines 4-61 Skladman). The user is able to select the notification from predefined options. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

3. With regards to claims 3, 6, 15 and 22, Skladman teaches through Lee, the method further comprising: automatically providing default tags, in the absence of contrary input from said sender, wherein said default tags may vary according to the status of said recipients

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). The user is able to select the notification from predefined options. Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). The automatic providing of default tags is a regular email feature. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either

by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These

flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the

invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

4. With regards to claims 4, 16 and 23, Skladman teaches through Lee, the method

   wherein said sender can compose the content of said tags

   (Skladman's design features a central storage location for the recipient's

   preferences (notification server) enabling the recipient's preferences to be accessed

   allowing for customized notifications (equivalent to the claimed compose trait) and

   flags (tags) based on sender (column 3, lines 4-61 Skladman). However, the

   notification server sets the tags of Skladman's design.

   Lee also teaches an email design. In Lee's design, the priority can be set either

   by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These

   flags are predefined.

   Both Skladman and Lee teach email designs allowing for priorities to be set.

   Therefore it would have been obvious to one skilled in the art, during the time of the

   invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

5. With regards to claim 5, Skladman teaches through Lee a method for sending

e-mail, from a sender to a plurality of recipients, comprising: providing tags, to

convey information about the importance of an e-mail message; receiving input from

said sender specifying said recipients of said e-mail message; and for each of said

recipients, receiving input from said sender specifying one of said tags to be placed

on said e-mail message, wherein said tags may vary from one of said recipients to

another

(Skladman teaches an email design that allows recipients to set preferences (in

filters) including preferences based on email addresses and priority schemes

(column 2, lines 21-34, Skladman). In addition, Skladman's design features a

central storage location for the recipient's preferences (notification server) enabling

the recipient's preferences to be accessed allowing for customized notifications and

flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore,

Skladman's design allows for regular email features (column 3, lines 33-57,

Skladman) hence claimed traits such as the sender specifying recipients are present

within Skladman's design. However, the notification server sets the tags of

Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either

by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). This is

particularly shown within lines 58-60, in column 20.

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the

invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

6. With regards to claim 7, Skladman teaches through Lee a method for providing

e-mail services, said method comprising: receiving input from a sender specifying a

recipient of an e-mail message; and communicating to said sender at least one of

said recipient's preferences concerning e-mail received by said recipient, before said

e-mail message is transmitted to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in

filters) including preferences based on email addresses and priority schemes

(column 2, lines 21-34, Skladman). In addition, Skladman's design features a

central storage location for the recipient's preferences (notification server) enabling

the recipient's preferences to be accessed allowing for customized notifications and

flags (tags) based on sender (column 3, lines 4-61 Skladman). Furthermore,

Skladman's design allows for regular email features (column 3, lines 33-57,

Skladman) hence claimed traits such as the sender specifying recipients are present

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within Skladman's design. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

7. With regards to claims 8, 11, 18 and 25, Skladman teaches through Lee, the method wherein said preferences concern the size of e-mail messages sent to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in filters) including preferences based on email addresses and priority schemes (column 2, lines 21-34, Skladman). The design allows for notifications to be based on various preferences (column 2, lines 54-65, Skladman). Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). Actions enforced on emails based on size are a regular email feature. However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set. Therefore it would have been obvious to one skilled in the art, during the time of the invention, to combine the teachings of Skladman with those of Lee, providing an improved system and method for composing, processing, and organizing electronic mails message items (column 4, lines 59-64, Lee)).

8. With regards to claims 9, 12, 19 and 26, Skladman teaches through Lee, the method wherein: said preferences concern rating the importance of said e-mail message, and; wherein said communicating further comprises: providing said preferences as a set of menu entries to said sender; receiving a menu entry selection signal from said sender; and in response to said signal, tagging said e-mail message, to implement said preferences

(Skladman's design features a central storage location for the recipient's preferences (notification server) enabling the recipient's preferences to be accessed allowing for customized notifications and flags (tags) based on sender (column 3, lines 4-61 Skladman). The user is able to select the notification from predefined options. Furthermore, Skladman's design allows for regular email features (column 3, lines 33-57, Skladman). However, the notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee). These flags are predefined.

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the

invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

9. With regards to claims 10, 17 and 24, Skladman teaches through Lee, a method for

providing e-mail services, said method comprising: maintaining a database

identifying at least one e-mail recipient and his or her corresponding preferences

concerning e-mail received by said recipient; and communicating at least one of said

preferences to a sender of an e-mail message, before said e-mail message is

transmitted to said recipient

(Skladman teaches an email design that allows recipients to set preferences (in

filters) including preferences based on email addresses and priority schemes

(column 2, lines 21-34, Skladman). In addition, Skladman's design features a

central storage location for the recipient's preferences (notification server, equivalent

to the claimed database) enabling the recipient's preferences to be accessed

allowing for customized notifications and flags (tags) based on sender (column 3,

lines 4-61 Skladman). Furthermore, Skladman's design allows for regular email

features (column 3, lines 33-57, Skladman) hence claimed traits such as the sender

specifying recipients are present within Skladman's design. However, the

notification server sets the tags of Skladman's design.

Lee also teaches an email design. In Lee's design, the priority can be set either

by the sender or the recipient (column 20, line 41 – column 26, line 59, Lee).

Both Skladman and Lee teach email designs allowing for priorities to be set.

Therefore it would have been obvious to one skilled in the art, during the time of the

invention, to combine the teachings of Skladman with those of Lee, providing an

improved system and method for composing, processing, and organizing electronic

mails message items (column 4, lines 59-64, Lee)).

Response to Remarks

The amendment received on August 16, 2005 has been carefully reviewed but is

not deemed fully persuasive. Within the amendment, no new claims are added nor are

any of the claims amended. Instead, the applicant's representative expresses concern

over three particular issues.

With regards to the first issue of concern, the applicant's representative states

that the examiner "admits" that the Skladman prior art does not teach the sender setting

the flags on the emails. The examiner would like to remind the applicant's

representative first that a 103-type rejection was provided with Skladman in combination

with Lee. In addition, after review of the 103-type rejection, it was determined that the

combination of the two prior arts was performed correctly and a satisfactory motivation

for combination of the two prior arts was provided. Within the Skladman prior art, the

notification server instead of a human sender sets the flags. However it is well known in

the art how human email senders are able to set flags and the Lee prior art

demonstrates that by showing how a sender or a recipient is able to set flags (column 20, lines 58-60, Lee).

With regards to the second issue of concern, the applicant's representative states that the examiner is not very specific as to what the Lee prior art contributes. A principle (but not sole) teaching that Lee provides is the fact that flags can be set by senders or recipients (column 20, lines 58-60, Lee). The six columns of the prior art were cited because they provide relevant information regarding the addition of flags to emails. The applicant's representative was provided this particular information regarding the Lee prior art, upon request during the phone interview of September 20, 2005.

Finally, the applicant's representative states their concern over the Lee prior art. The applicant's representative states that they "could not find anything suggestive of sender input to a recipient of an E-mail message which creates a priority tag specific to that recipient which varies from the priority tag sent by the recipient which varies from the priority tag sent by the sender of the same E-mail message to another recipient." Once again, the examiner would like to remind the applicant's representative that a 103-type rejection was provided with Skladman in _combination_ with Lee. It is through the teachings of Skladman in combination with Lee that one skilled in the art can see how such a design lacks novelty. Specifics are provided within rejections to claims 1 and 5.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Azizul Choudhury whose telephone number is (571) 272-3909. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

AC

JASON CARDONE
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